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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,264	01/23/2002	David Henry Levy		8694
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FISH & RICHARDSON PC			EXAMINER	
P.O. BOX 1022			ORTIZ, BELIX M	
MINNEAPOLIS, MN 55440-1022			ART UNIT	PAPER NUMBER
			2164	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/053,264	LEVY, DAVID HENRY
	<b>Examiner</b>	<b>Art Unit</b>
	Belix M. Ortiz	2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 July 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 3-10 and 27-40 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 3-10 and 27-40 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

## DETAILED ACTION

### Remarks

1. In response to communications files on 27-July-2005, claims 1-2 and 11-26 are cancelled; claims 3-8 are amended; and claims 27-40 are added per applicant's request. Therefore, claims 3-10 and 27-40 are presently pending in the application.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
3. Claims 3-7, 10, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Padwick et al.

As to claim 3, Padwick et al. teaches a text editing system comprising:  
an electronic document generation module configured to allow a user to generate an electronic document (see page 1, paragraph 4-12);  
to receive from the user a predefined string of characters identifying the location of unknown information, and to enter into the electronic document a placeholder for the unknown information at the location specified by the user with the predefined string (see page 4, figure 3.30);

an active messaging module configured to recognize the predefined string of characters as entered into the electronic document and, after recognizing in response the predefined string of characters, to automatically open a messaging window on a display that permits the user to compose a message requesting the unknown information from one or more recipients (see Page 2 paragraph 2 and figures 3.30, 3.39, and 3.40 and page 4, paragraph 4).

As to claim 4, Padwick et al. teaches wherein said message window includes: a context window, said context window to include a subset of said document proximate the location of said predefined string of characters (see page 4, figure 3.30).

As to claim 5, Padwick et al. teaches wherein the active messaging module is further configured receive a response from a recipient and display the response to the user (see page 26, paragraph 10).

As to claim 6, Padwick et al. teaches wherein the active messaging module is further configured to automatically integrate the response into the electronic document in response to receiving approval from the user (see page 26, paragraphs 10-11 and page 27, figure 3.48 and paragraphs 2-3).

As to claim 7, Padwick et al. teaches wherein the active messaging module is further configured to permit the user to edit the response (see page 29, paragraph 2).

As to claim 10, Padwick et al. teaches wherein the active messaging module is further configured to automatically integrate an edited response into the electronic document (see page 26, paragraphs 10-11 and page 27, figure 3.48 and paragraphs 2-3).

As to claim 27, Padwick et al. teaches wherein the predefined string of characters comprises text typed by the user into the electronic document (see figure 3.30 and page 4, paragraph 4).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 8-9, 28-35, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gough et al. (U.S. patent 6,360,221) in view of Padwick et al.

As to claim 8, Gough et al. teaches a computer-implemented document editing method (see column 1, lines 6-13) comprising:

receiving a predefined string of characters into an electronic document entered by a user, wherein the predefined string of characters represents a placeholder for unknown information (see figure 2);

transmitting the query to a database located remotely from the first computing device (see figure 13);

identifying, from the context data included in the transmitted query, what information is unknown (see figure 8);

transmitting a response containing responsive information to the first computing device (see figure 13).

Gough et al. does not teach recognizing the predefined string using a first computing device, and, in response to recognizing the predefined string automatically assembling a query that includes a set of context data extracted from text a portion of the electronic document disposed proximate to the placeholder; and

searching the database for the unknown information.

Padwick et al. teaches creating, sending, and receiving electronic document (see manual), in which he teaches recognizing the predefined string using a first computing device, and, in response to recognizing the predefined string automatically assembling a query that includes a set of context data

extracted from text a portion of-the electronic document disposed proximate to the placeholder (see figure 3.30, 3.33, 3.39, and 3.40);  
searching the database for the unknown information (see page 1, paragraphs 8 and 9).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Gough et al. by the teaching of Padwick et al., because, recognizing the predefined string using a first computing device, and, in response to recognizing the predefined string automatically assembling a query that includes a set of context data extracted from text a portion of-the electronic document disposed proximate to the placeholder;

searching the database for the unknown information, would enable the method because, the user can response to the sender faster and the user can attach more information to the electronic message.

As to claim 9, Gough et al. as modified teaches the method further comprising:

automatically inserting the responsive information into the electronic document in response to receiving an approval from the user (see page 26, paragraphs 10-11 and page 27, figure 3.48 and paragraphs 2-3).

As to claim 28, Gough et al. teaches a method of editing a text document, the method comprising:

opening an electronic document with a document editing program (see column 6, lines 63-67);

manually entering a predefined string of characters into the open text document, causing the document editing program to recognize the entered string of characters as a placeholder for missing information, and in response to recognizing the string of characters, to open a messaging window (see column 8, lines 16-31);

generating in the messaging window a query regarding the missing information (see figure 8);

forwarding the query to one or more identified recipients (see column 8, lines 16-31);

receiving a response to the query (see figure 13); and  
automatically updating the saved document to contain information contained within the response (see column 8, lines 16-31).

Gough et al. does not teach saving the electronic document on a computing device.

Padwick et al. teaches creating, sending, and receiving electronic document (see manual), in which he teaches saving the electronic document on a computing device (see figure 3.38).

It would have been obvious to a person having ordinary skill in the art

at the time the invention was made to have modified Gough et al. by the teaching of Padwick et al., because, saving the electronic document on a computing device, would enable the user to see or review the message in another time.

As to claim 29, Gough et al. as modified teaches wherein the message window includes a portion of the electronic document surrounding the placeholder (see Padwick et al., figure 3.36).

As to claim 30, Gough et al. as modified teaches the method further comprising:

enabling the user to vary the portion of the electronic document that is included in the message window (see Padwick et al., page 29, paragraphs 1-2).

As to claim 31, Gough et al. as modified teaches wherein the message further includes a messaging area in which the user can enter a message to the one or more recipients (see Padwick et al., page 1, paragraph 9; page 4, figure 3.30 and paragraph 5; and page 7, figure 3.32).

As to claim 32, Gough et al. as modified teaches wherein the one or more recipients includes a person (see Padwick et al., page 1, paragraph 9; page 4, figure 3.30 and paragraph 5; and page 7, figure 3.32).

As to claim 33, Gough et al. as modified teaches wherein the predefined string of characters comprises a single character (see Padwick et al., page 4, figure 3.30 and page 9, figure 3.33).

As to claim 34, Gough et al. as modified teaches the method further comprising, after receiving the response, displaying the response to the user and enabling the user to approve the response before automatically updating the saved document (see Padwick et al., page 26, paragraph 11 and page 29, paragraph 2).

As to claim 35, Gough et al. as modified teaches wherein the predefined string of characters consists of a string of alphanumeric characters (see Gough et al., figure 8, character 804).

As to claim 38, Gough et al. as modified teaches wherein the predefined string of characters comprises typed text (see Gough et al., figures 3 and 8).

As to claim 39, Gough et al. as modified teaches wherein the query is forwarded to a person, a web agent, a database, or a data mining engine (see Gough et al., claim 31).

As to claim 40, Gough et al. as modified teaches wherein the identified recipients include the user (see Gough et al., figures 3 and 13).

6. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gough et al. (U.S. patent 6,360,221) in view of Padwick et al. as applied to claims 8-9, 28-35, and 38-40 above, and further in view of Birrell et al. (U.S. patent 6,185,551).

As to claim 36, Gough et al. as modified still does not teach wherein automatically updating the saved document comprises replacing the placeholder with the information contained within the response.

Birrell et al. teaches web-based electronic mail service apparatus and method using full text and label indexing (see abstract), in which he teaches wherein automatically updating the saved document comprises replacing the placeholder with the information contained within the response (see column 15, lines 3-10).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Gough et al. by the teaching of Birrell et al., because wherein automatically updating the saved document comprises replacing the placeholder with the information contained within the response, would enable the user to have just the latest information and the message is clear and short.

As to claim 37, Gough et al. as modified teaches wherein automatically updating the saved document further comprises replacing information proximate the placeholder (see Birrell et al., column 15, lines 3-10).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Belix M. Ortiz whose telephone number is 571-272-4081. The examiner can normally be reached on moday-friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bmo

September 2, 2005



CHARLES RONES  
PRIMARY EXAMINER